

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 54

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINICHI TSUBOI,
SHINZABURO SONE, TORU OBINATA,
OTTO EXNER, and MICHAEL SCHWAMBORN

Appeal No. 1999-0341
Application No. 08/543,351

ON BRIEF

Before WINTERS, SPIEGEL, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 14-16, which are all the claims pending in the application.

Claims 14 and 16¹ are illustrative of the subject matter on appeal and are reproduced below:

14. A method of protecting wood, paper, leather, polymers or textiles against attack by insects which comprises applying thereto an amount sufficient to effect protection thereof of the compound 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine.
16. The method according to claim 14, wherein paper, leather, polymers or textiles are protected.

The reference relied upon by the examiner is:

Shiokawa et al. (Shiokawa) 4,742,060 May 3, 1988

GROUND OF REJECTION

Claims 14 and 15 are rejected as being anticipated by Shiokawa, under 35 U.S.C. § 102 or obvious thereover under 35 U.S.C. § 103.

Claim 16 is rejected under 35 U.S.C. § 103 as being unpatentable over Shiokawa.

We affirm both of the examiner's rejections.

DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. We make reference to the examiner's Answer (Paper No. 43, mailed June 19, 1997), for the examiner's

¹ Claim 16 is incorrectly recited as depending from claim 7 in appellants' appendix of claims. Claim 16 properly depends from claim 14. Claim 16 is correctly reproduced herein.

reasoning in support of the rejection. We further reference appellants' Brief (Paper No. 42, filed March 17, 1997), and appellants' Reply Brief (Paper No. 44, filed August 4, 1997) for the appellants' arguments in favor of patentability.

CLAIM GROUPING:

Appellants state (Brief, page 4) "[t]he appealed claims do not stand or fall together because they were not rejected together." Appellants point out that claims 14 and 15 were rejected in one rejection and claim 16 in another. Thus, we interpret appellants' comments as setting forth two claim groupings group I, claims 14 and 15, and group II claim 16. We will therefore limit our discussion to claims 14 and 16.

Rejection Under 35 U.S.C. §§ 102 or 103:

Claim 14:

The examiner's basis for the rejection is as follows:

The above prior art clearly teaches that the claim designated compound is an old insecticide applied to the same locus of the claims rendering the instant claims unpatentable. Column 12, lines 50 and 51; and column 58, lines 30-35 teach the claimed compound. Column 54, lines 18-20 teaches the same locus (wood) as in the claims.

In response to the examiner's rejection appellants state (Brief, page 5) that "[w]hile [a]ppellants agree Shiokawa suggests that one could protect wood, it is submitted that this disclosure does not raise to the level of anticipation." Appellants support this argument by stating (Brief, page 5) that "Shiokawa ... does not teach a specific example where any [of] the insecticides disclosed therein will preserve technical materials, let alone with the instantly claimed insecticide." Appellants

assert (Brief, page 6) “that each and every element of the claims is not taught as this [Shiokawa] reference does not provide a working example in which wood is protected.

Appellants argue (Brief, page 7) that since none of the examples in Shiokawa teach protecting wood, the passage (Shiokawa, column 54, lines 18-21) relied upon by the examiner must be a “generic teaching which suggests but does not anticipate the instant invention.” Appellants state (Brief, page 9) “[a]s Shiokawa does not specifically teach 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazoline can be used to preserve wood or other materials, it is respectfully submitted this reference cannot anticipate claims 14 and 15.”

In order to anticipate the reference must describe the applicants’ claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

With this in mind we start our analysis by considering, as directed by the examiner, column 58, lines 30-35 of Shiokawa which teaches “Compound No. 11” the same compound recited by appellants (Brief, page 13) as “[t]he compound of the instant [appealed] claim[s].” Compound No. 11, is the same compound found in Shiokawa’s claim 21 which states “1-(2-chloro-5-pyrimidinylmethyl)-2-(nitroimino)imidazolidine according to claim 1 of the formula” Thus, Shiokawa clearly identifies 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine, as a species within claim 1.

Claim 28 of Shiokawa states “[a method of combating insects which comprises applying to ... an insect habitat an insecticidally effective amount of a compound according to claim 1.” In this context we look to the examiner’s citation of Shiokawa, column 54, lines 18-21, which states “[w]hen used against ... pests of stored products, the active compounds are distinguished by an excellent residual action on wood”

A fair reading of the reference demonstrates that Shiokawa describes appellants’ claimed invention sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention. Specifically, Shiokawa discloses a method of combating insects (e.g. pests of stored products) which comprises applying to an insect habitat (e.g. stored products) an insecticidally effective amount of a compound according to claim 1 (which according to claim 21, clearly includes 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine). Thus, contrary to appellants’ position each and every element of the claim is taught by Shiokawa.

Accordingly, we affirm the examiner’s rejection of claims 14 and 15 under 35 U.S.C. §102 as anticipated by Shiokawa.

A disclosure that anticipates under 35 U.S.C. §102 also renders the claim invalid under 35 U.S.C. §103, for anticipation is the epitome of obviousness. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983), citing, In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982).

Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. § 102 rejections and thus cannot

overcome a rejection so based. In re Wiggins, 179 USPQ 421, 425 (CCPA 1973).

Therefore, we do not consider, appellants' arguments regarding the Tsuboi Declaration² (Brief, pages 9-16) or the alleged unexpected results found therein.

Claim 16:

The examiner's basis for the rejection is as follows:

The prior art clearly teaches that the claim designated imidazolidine is an old insecticide. Therefore, one skilled in this art would find ample motivation from the prior art *supra* to use the claimed compound, known for its insecticide properties, to protect materials, such as paper, leather, polymers or textiles from the target insects of the instant application with a reasonable expectation that said compound would be effective to protect said materials from insects.

In response to the examiner's rejection appellants argue (Brief, page 16) that Shiokawa "is completely silent" with regard to preserving leather, polymers or textiles from attack by insects, and the examiner has not established that wood and clay are equivalent to these materials.

We note claim 28 of Shiokawa which states "[a] method of combating insects which comprises applying to ... an insect habitat an insecticidally effective amount of a compound according to claim 1." As discussed supra, the active compound, of the appealed method claims, is specifically identified as a species within claim 1. Column 54, lines 18-21 of Shiokawa, disclose the use of the active compounds against pests of "stored products." As stated by the examiner (Answer, bridging paragraph, pages 5-6):

² The Tsuboi Declaration, executed November 1, 1993, was made of record in Application No. 07/872,279 (Paper No. 24, received December 19, 1993), now

[O]ne skilled in this art would find ample motivation from the prior art supra to use the claimed compound, known for its insecticide properties, to protect materials, such as paper, leather, polymers or textiles from the target insects of the instant application with a reasonable expectation that said compound would be effective to protect said materials from insects.

We agree with the examiner, that it would have been prima facie obvious to apply the known insecticide taught by Shiokawa to a stored product that may be paper, leather, polymers or textiles, with the reasonable expectation that these stored products would be protected from insects.

Appellants argue (Brief, bridging paragraph, pages 17-18) that “the data presented in the specification as well as the data presented in the Declaration of Dr. Tsuboi demonstrate 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine) has unexpected properties in preserving technical materials such as paper, textiles, etc.” In order to establish unexpected results for a claimed invention, objective evidence of non-obviousness must be commensurate in scope with the claims that the evidence is offered to support. In re Greenfield, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (1972); In re Tiffin, 448 F.2d 791, 792, 171 USPQ 294 (1971).

Applying this rule to appellants' claim, we note that claim 16 is drawn to the protection of paper, leather, polymers or textiles. In contrast, the Tsuboi Declaration is limited to the protection of wood. In addition, the data presented in the specification, pages 21-29 is similarly limited to the protection of wood. In fact the

only example provided in appellants' specification which relates to claim 16 is example 8 (page 18). Here an insecticidal solution was applied to filter paper, prior to introduction of termites. As reported in table 1 (specification, page 20) both the imidazolidine compounds (I-1 and I-3) and the thiazolidine compound (I-2) all exhibited the same activity, measured by mortality of termites after four days. As a result, we find nothing in this example which renders the method of claim 16 unexpected. Therefore, we conclude that the evidence of unexpected results was not commensurate in scope with the breadth of the claim.

Accordingly, we affirm the examiner's rejection of claim 16 under 35 U.S.C. § 103 as being unpatentable over Shiokawa.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Sherman D. Winters)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
Carol A. Spiegel)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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Donald E. Adams)	
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